

Favorable decision in class action against the Brazilian Patent Office

Restoration of Patents in Brazil: An Important Victory for Patentees

By Gabriel Leonardos | Gabriel.Leonardos@kasznarleonardos.com
And Luciana Minada | Luciana.Minada@kasznarleonardos.com

As informed in our Newsletters # 2 (January 2014) and # 6 (August 2014), a serious controversy regarding the restoration of patents and of patent applications with annuities in arrears arose from the enactment by the Brazilian Patent Office (hereinafter "INPI") of Resolution No. 113/2013 (hereinafter "INPI's Resolution"). Such controversy is due to the contradiction between item 13 of INPI's Resolution and Sections 86 and 87 of the Brazilian Industrial Property Act (Law No. 9,279/96 – IP Act): although the IP Act allows the restoration of the patent or of the application upon request of its owner within 3 (three) months from the publication of the forfeiture's notice, INPI's Resolution set forth that in case multiple annuities (two or more) are left unpaid, a patent or a patent application could no longer be restored.

Given that, on July 10, 2014, the Brazilian Association of Industrial Property Agents (ABAPI) filed a class action before the 25th Federal Court of Rio de Janeiro, aiming the invalidation of item 13 of INPI's Resolution and the reversion of all the definitive shelving and extinction decisions that were based on such provision.

Recently, on January 13, 2015, Federal Judge Eduardo André Brandão de Brito Fernandes rendered his decision and granted ABAPI's requests, determining that all shelving and extinction decisions based on item 13 of INPI's Resolution are void and ordering that INPI complies with Section 87 of IP Act, i.e., patentees must be notified so that, if it is of their interest, they might be able to restore its patent or application by paying the proper official fees. Such decision also granted the injunction request to immediately suspend the effects of item 13 of INPI's Resolution and, therefore, it will have immediate effect and the 9,745 patents and patent applications that had already been declared shelved and extinct by INPI must now be reinstated.

INPI will probably try to reverse the court decision by filing an Appeal to the Regional Federal Court; hence, our firm will continue to monitor this class action closely. Any other news on this matter will be reported to you. Meanwhile, we remain at your service should you need any additional information or any specific legal advice as to the possibility of restoration of patents and patent applications with annuities in arrears.